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09/957,490	09/19/2001	Mark Roland Boeder	10451.0028.NPUS00	3149

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[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1661

DATE MAILED: 08/20/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/957,498	Applicant(s) BOEDER
	Examiner KIZILKAYA	Group Art Unit 1661

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on 5/19/03.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- Claim(s) 1 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 1 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) _____.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- | | |
|--|---|
| <input type="checkbox"/> Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ | <input type="checkbox"/> Interview Summary, PTO-413 |
| <input type="checkbox"/> Notice of Reference(s) Cited, PTO-892 | <input type="checkbox"/> Notice of Informal Patent Application, PTO-152 |
| <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review, PTO-948 | <input type="checkbox"/> Other _____ |

Office Action Summary

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DETAILED ACTION

Rejection of the Disclosure

35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Status of Application

Applicant's responses by sub-spec has been received and entered as numbers 6 on May 19, 2003.

All elements which comprised the Objection to the disclosure under 37 CFR 1.163 and 35 USC 112 have been resolved by applicant.

Claim Rejection

35 U.S.C. § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by printed publications provided by applicant in the form of catalogs (1999 and 2000 Ficor catalogs). In addition to applicant's admission that the invention was placed in the public domain more than one year prior to the US filing date.

Response to Arguments

As applicant points out in the Remarks section of the response submitted May 19,

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2003, examiner was mistaken regarding the presence of a PBR application for the instant plant. Rather, the prior art provided by applicant were the printed publications of Ficor plant catalogs from 1999 and 2000, first publicly distributed according to applicant in October of 1998 which was more than one year prior to the U.S file date of September 19, 2001.

The catalogs are each “printed publications” under 35 U.S.C. 102 because they are accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. Thus information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art. Furthermore, the publications in question also indicate the plant was not only disclosed in a printed publication but also that the plants were available in the public domain.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d 1618, 1620, (Bd. Pat. App. & Inter. 1992)(“The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”).

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A. While the publications cited above disclosed the claimed plant variety, the question remained as to whether the references are enabling. If the plant was publicly available, then the published application, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. Based on applicant's response the instant plant was in fact publicly available more than one year prior to the U.S. filing.

B. In response to applicant's assertion that it is improper to combine references, the office is in complete agreement. However, in this case the combining of references has not occurred as the public availability of the invention is not prior art nor a reference per se.

C. As for foreign public use and on-sale activity, applicant insists such is not a factor under 102(b). According to applicant,

"Until an invention is described in a printed publication or patented outside the United States, the foreign use is not deemed to have made the invention available in this country".
First, this assertion does not overcome the issue that the publications did occur more than one year prior to the US filing. Nevertheless, the fact remains it is in fact a printed publication.
Second, applicant's understanding of availability appears misplaced as there is no geographic component to enablement. A reference is enabling if it allows anyone, anywhere, to make and use the invention.

More specifically, the rejection is not based on the public use and on-sale bar to 102,

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(which does apply only in the U.S.), rather the rejection is based on the printed publication bar of 102. So while foreign use and sale wouldn't matter if there was no publication to document the fact that it was in use. Such is not the case for the instant invention as it was both published and available.

D. Ficor catalogs are indeed sufficient means to place the public in the possession of the claimed variety as these catalogs are clearly advertisements for the purpose of sale. Whether applicant is aware of sale outside the US is irrelevant as there is simply no geographical component to enablement.

E. Regarding the assertion that the Ficor catalogs combined with non-US use and availability is an improper rejection applicant is reminded that the “sufficient disclosure in the reference to place the public in possession of the variety by more than name alone.”, has been obviously accomplished as the publications in question are actual sales advertisements. Therefore, not only were the publications a means of making the invention available to the public, but applicant's contention that the catalogs are, “merely a pretense for a rejection based in reality upon the public use and availability of the variety outside the United States.”, is highly misplaced especially considering the issue of availability has no geographical limitation.

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In Conclusion, no claim can be allowed the previously made 102(b) rejection has not been overcome.

THIS ACTION IS MADE FINAL.

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michelle R. Kizilkaya whose telephone number is (703) 308-4324. The Examiner can normally be reached Monday through Friday from 9:00 am to 5:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

M. R. Kizilkaya / mrk



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